

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE J. MORRISON, DEAN B. MORRISON
and ADAM MORRISON

Appeal No. 94-4173
Application 07/868,492¹

ON BRIEF

Before WILLIAM F. SMITH, WEIFFENBACH and ELLIS, **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8 through 16. Claim 17 is also pending, but was withdrawn from consideration by the examiner in accordance with 37 CFR § 1.142(b).

¹ Application for patent filed April 15, 1992. According to the appellants, this application is a continuation-in-part of Application 07/617,030, filed November 21, 1990, now abandoned.

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Claims 8 and 15 are illustrative of the subject matter on appeal and read as follows:

8. A method of extending the life of a pesticidal composition comprising a mixture of dichlorvos and chlorpyrifos, said method comprising subjecting said mixture to microwave radiation to extend life of the pesticidal composition.

15. An aqueous pesticidal composition having improved residual pesticidal protection prepared by the method of Claim 8.

The references relied on by the examiner are:

Sears	4,514,960	May 07, 1985
Allan et al. (Allan)	4,554,155	Nov. 19, 1985
Wilson	4,707,355	Nov. 17, 1987

Claims 8 through 14 stand rejected under 35 U.S.C. § 103 as unpatentable over Sears in view of Wilson and Allan.

Claims 15 and 16 stand rejected under 35 U.S.C. § 102(b) as unpatentable over Wilson.

We **reverse** both rejections.

Rejection under 35 U.S.C. § 103

It is well settled that the examiner has the initial burden of establishing a **prima facie** case of obviousness. **In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); **In re Rinehart**, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). This burden can be satisfied when the examiner provides objective evidence that some teaching or suggestion in

the applied prior art, or knowledge generally available, would have led one of ordinary skill in the art to combine the teachings of the references and to produce the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The teaching or suggestion must be in the prior art, and not in the applicants' disclosure. ***In re Dow Chemical Co.***, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988). In the case before us, the examiner has not provided a single, coherent reason,² based on the applied references, or general knowledge, as to why it would have been obvious to one of ordinary skill in the art to arrive at the claimed method of extending the life of a pesticidal composition by microwaving a mixture of dichlorvos and chlorpyrifos. Accordingly, the rejection is reversed.

² We direct attention to the examiner's conclusion on p. 5 of the final rejection (Paper No. 6) that

[i]t would have been obvious to one of ordinary skill in the art to modify Sears with the teachings of Wilson and allan [sic, Allan] et al. since Sears teaches a bait as suggested by Wilson who teaches the ***specific*** organophosphates [sic, organophosphates] suggested by Sears and Allan et al. suggests pva may be used with pesticides including chlorpyrifos and dichlorvos.

Rejection under 35 U.S.C. § 102(b)

According to the examiner, "Wilson ('355) discloses the structural limitations of the instant claims. Namely dichlorvos and chlorpyrifos (column 3, lines 57-68) mixture." Final rejection (Paper No. 6), p. 4. We recognize that when the claimed and prior art products appear to be "identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). Here, however, we do not find that the composition disclosed by Wilson is made by the same or substantially the same method as the claimed composition; nor does the examiner contend that they are. Rather, what we find on this record is an assertion by the examiner that the composition in representative claim 15 has the same basic components as the composition described by Wilson. Final rejection, p. 4. However, the examiner has not provided any explanation as to the basis for his finding. Without an explanation or reasons, it is improper for the to shift the burden to the appellants to establish that the "product produced by microwave radiation produces a structurally

unique pesticidal composition which is unlike a simple mixture of dichlorvos and chlorpyrifos"; i.e., that there is a difference between the claimed and prior art products. Answer, p. 5.

Inherency must be based on inevitability, and not speculation.

In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)

("[i]nherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient").

Accordingly, the rejection is reversed.

Since the examiner has not discharged his responsibility of establishing a ***prima facie*** case of (i) obviousness for the method of claims 8 through 14, or (ii) anticipation of the compositions of claims 15 and 16, we need not consider the experimental data in Tables 1-3 of the specification relied on by the appellants for purposes of rebuttal.³

³ We do, however, direct the examiner's attention to the statement in the Reply Brief that

[t]his is the first time that the Examiner has criticized Appellant's [sic, Appellants'] evidence in support of patentability. This "sandbagging" approach to examination is clearly improper, grossly unfair to Appellant [sic, Appellants], and should not be tolerated.

We agree.

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Accordingly, the decision of the examiner is reversed.

REVERSED

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WILLIAM F. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CAMERON WEIFFENBACH)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
JOAN ELLIS)	
Administrative Patent Judge)	

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